



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/381,828	11/24/1999	ROLF SKOLD	2964-102P	4478

7590 03/31/2004

BIRCH STEWART KOLASCH & BIRCH  
PO BOX 747  
FALLS CHURCH, VA 220400747

EXAMINER

SODERQUIST, ARLEN

ART UNIT	PAPER NUMBER
----------	--------------

1743

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/381,828

Applicant(s)

SKOLD, ROLF

Examiner

Arlen Soderquist

Art Unit

1743

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.


The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 3 and 9.Claim(s) rejected: 1,2,4-8 and 10.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: Interview summary included

  
ARLEN SODERQUIST  
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: of the reasons of record and the following additional comments. Examiner appreciates the table attempting to show the difference between claim 1 and the applied art. Examiner would like to note that the table is dealing with anticipation of the claim by the art. Examiner does not dispute that the claims are not anticipated by the art. To begin with it would be instructive and constructive to go through and try to place the basis for each of the 11 features that applicant feels are found in the claim with the actual language of claim 1. First, automation (feature 1) is found in the claim in the provision of a control program for changing the concentration of a component, through the calculation of of the component concentration in a computer and through the storage of the measuring points. There is also the possibility of a temperature control program, however this control program is not required because the temperatures can also be determined by measurement. Examiner agrees that feature number 2 is present in the claim in section 1) of the claim in particular. Features 3 and 4 are also found in the claim in the above mentioned sections. Examiner disagrees that feature 5 is a required feature of the claim. The only place that a temperature control program is found in the claim is as a calculation alternative to measuring the temperature. Thus the temperature is not required to be controlled by a control program and a manual setting of the temperature is fully within the claim scope. Feature 6 sets forth the alternative methods of determining the temperature and is in the claim. Features 7-8 are found in the claim, particularly in section 3) of the claim. Features 9-10 are found in the claim, particularly in sections 5) and 6) of the claim. Finally feature 11 appears to be a duplicate of feature 4 and is found in the claim in section 2 of the claim. From this analysis it is clear that applicant's representation of the scope of claim 1 is not correct in that feature 5 is not required, since as feature 6 clearly states the temperature is determined by alternative methods and there is not a temperature control program in claim 1 except as a part of one of the two alternative methods for determining the temperature. Additionally the claim does not require total automation of the process since only a computer and control program for changing concentration and storing and displaying a three dimensional diagram are specifically required by the claim. As a result of the above analysis examiner takes issue with the representation of the Franchini reference in the table regarding features 5-6 and 9-10. Since the temperatures can be measured and Franchini clearly has temperature data, features 5-6 are found in Franchini. Additionally Franchini used a computer to produce the three dimensional diagram and therefore the values have been combined in the computer to produce the diagram which is consistent with features 9-10. The Baxter reference has teachings related to the skill of the art and also relevant to feature 10 since it talks about generation of a three dimensional surface. The Cunha reference contains teachings related to feature 3 and at least measurement of a property in addition to the automation which applicant has indicated. The Renoe reference contains teachings regarding the skill of one of ordinary skill in the art in addition to the features that applicant has marked. Examiner disagrees with the analysis of the Bader reference as has previously been discussed since the reference clearly teaches feature 7 in addition to tying it to analytical methods in which multiple solution concentration are produced in the analytical process. The Laughlin paper is also relevant to feature 7 in producing concentration dependent measurements in which the concentration is varied over a range of values. The Li reference relates to computer control (automation) of the experiments in addition to other components of the claim related to analysis of solutions having a varying concentration of component(s). The Rodriguez reference relates to the skill of one of skill in the art and constant volume experiments. The Saxberg reference is likewise related to the skill of one of ordinary skill in the art and the addition of components to a sample being analyzed when multiple concentrations are used in the analysis. One additional part of the obviousness rejection which applicant does not include in the table which is relevant to the question of obviousness is how the Courts have treated automation as a patentable difference between the teachings of a reference and the claimed invention. On this point the Court has decided that automation of a manual procedure is not a patentable difference. This in combination with the teachings of Cunha and Renoe should lay to rest any question related to the obviousness of the components of claim 1 related to automation and its associated computer or control programs relative to the Franchini reference. This includes the issue of motivation since these references are clear on the advantages of automation of tasks. The other difference between claim 1 and the primary reference, Franchini, feature 7, has previously been the subject of applicant's arguments and has been fully addressed by the examiner in previous office actions.